

10/732,843
END5007USNPRemarksStatus of Claims

Claims 1-13 and 16-22 are rejected. Claims 1, 6, and 17 are amended. Claim 10 is cancelled. Claims 1-9, 11-13, and 16-22 are pending.

The Claim amendments are supported by the application as filed, including canceled Claim 10. No new matter is added.

Claim Objection:

Claims 21 and 22 have revised status indicators as requested by the Examiner... Withdrawal of the objection is requested.

§103 Rejections

The rejection of the claims as obvious over Burbank (5,526,822) in view of Banik (6053877) and further in view of Bryan (6488636) is improper for all the reasons set forth in the prior response.

Further, Claims 1 and 16 are amended to recite the sample tube comprises a vacuum lumen and a sample lumen, and wherein the vacuum lumen extends along side of at least a portion of the sample lumen

The Examiner admits that Burbank in combination with Banik and Bryan does not teach a sample tube comprising a vacuum lumen and a sample lumen. It is respectfully urged that the Examiner does not have a prima facie case of obviousness where the combined references fail to disclose all the claim limitations, as acknowledged by the Examiner.

The Examiner's reason for rejecting the claim is supported by motivation provided by the art of record. The Examiner's statement that in view of Burbank discloses a structure in Figure 16 with respect to a biopsy needle, that it would have been obvious at the time the invention was made to modify the "sample tube" of Burbank et al as modified by Banik et al and Bryan et al. to comprise both a vacuum lumen and a sample lumen to provide uniform vacuum to draw in the tissue samples, is nothing more than improper hindsight reconstruction of the Applicant's invention.

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This is not sufficient to provide a prima facie case of obviousness. The Examiner admits that even if one combines all three references, the resulting combination would not provide the invention as claimed.

It is respectfully urged that the Examiner must provide some basis in the prior art for not only combining the references, but also for modifying the proposed combination.

Here, the Examiner has combined the references with no motivation, and then "filled in the blanks" by assuming that one would have some motivation to further modify the combined references to provide a feature that is not disclosed in any of the references.

The rejection of Claim 17, as amended, is also improper for at least the reasons set forth above.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims that are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments, including those made in previous responses, with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

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Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

/Gerry Gressel/
Gerry Gressel

Reg. No. 34,342
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(513) 337-3535